

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 106

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

KUNIHISA HOSHINO, DECEASED, BY CHIE HOSHINO,
LEGAL REPRESENTATIVE, YOSHINARI HAMANISHI,
and KEN UTAGAWA

Junior Party,¹

v.

TSUNEFUMI TANAKA

Senior Party.²

Patent Interference No. 103,208

Before STONER, Chief Administrative Patent Judge, PATE and

¹ Application 07/245,967, filed September 16, 1988, now Patent No. 4,841,325, issued June 20, 1989; and Reissue application 08/204,661, filed March 2, 1994. Both applications are accorded the benefit of application 07/005,241, filed January 20, 1987, and Japanese application JP61-012391, filed January 22, 1986.

² Application 07/573,270, filed August 27, 1990. Accorded the benefit of applications 07/453,170, filed December 26, 1989, 07/193,218, filed May 11, 1988, and 06/913,343, filed September 30, 1986. Also accorded the benefit of Japanese applications 61-058453, filed March 17, 1986, and 60-219521, filed October 2, 1985.

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LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

FINAL DECISION

In this interference, junior party Hoshino et al. (Hoshino) relies solely on the earlier filing dates of previously filed United States and Japanese applications to which it claims benefit, to establish the case for priority. For party Hoshino, the earliest accorded benefit date is January 22, 1986 (based on the Administrative Patent Judge's granting of Hoshino's motion for benefit). For party Tanaka, the earliest accorded benefit date is October 2, 1985 (based on the Administrative Patent Judge's granting of Tanaka's motion for benefit).

At final hearing, the parties seek review only of the Administrative Patent Judge (APJ)'s decision on various preliminary and miscellaneous motions filed by the parties.

On September 12, 1995, the APJ issued a decision on motions which decided party Hoshino's motions H1 through H7 and party Tanaka's motions T1 through T12. For clarification purposes, the list of motions decided by the APJ is

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reproduced below:

- H1 Hoshino et al.'s motion (Paper No. 13) under 37 CFR § 1.633(h) to add reissue application 08/204,661 of Hoshino et al.'s involved patent to this interference. (Unopposed)
- H2 Hoshino et al.'s motion (Paper No. 14) under 37 CFR § (c)(1) to add proposed counts 2, 3 and 4; under 37 CFR § 1.633(c)(3) to designate various claims of both parties as corresponding to proposed counts 2-4; under 37 CFR § 1.633(c)(4) to
- designate various claims of both parties as not corresponding to count 1; and under 37 CFR § 1.633(c)(5) to require Tanaka to add claims 40-53. (Opp. Paper No. 22) (Reply Paper No. 44)
- H3 Hoshino et al.'s motion (Paper No. 16) under 37 CFR § 1.633(f) for benefit of parent application 08/005,241 (January 20, 1987) and Japanese application 61-12391 (January 22, 1986). (Unopposed)
- H4 Hoshino et al.'s contingent motion (Paper No. 17) under 37 CFR § 1.633(c)(3) to alternatively designate certain claims to various proposed counts 2, 3 and 4. (Opp. Paper No. 25) (Reply Paper No. 45)
- H5 Hoshino et al.'s motion (Paper No. 34) to excuse delay in opposing Tanaka's motion for benefit. (Opp. Paper No. 53) (Reply Paper No. 66).
- H6 Hoshino et al.'s contingent motion (Paper No. 41) under 37 CFR §§ 1.633(f) and (j) to obtain the benefit of U.S. Application

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07/005,241 and Japanese application 61-12391.
(Unopposed)

- H7 Hoshino et al.'s motion (Paper No. 12) under 37 CFR § 1.633(a) that Tanaka's claims 34-39 are unpatentable to Tanaka. (Unopposed)
- T1 Tanaka's Motion for Benefit under 37 CFR § 1.633(f) (Paper No. 9), of the filing dates of Japanese applications 61-058453 (March 17, 1986) and 60-219521 (October 2, 1985). (Opp. Paper No. 35) (Reply Paper No. 54)
- T2 Tanaka's Motion to Redefine I, under 37 CFR § 1.633(c)(2) and (i) by amending his claims 34-38 and by canceling his claim 39. (Paper No. 24) (Opp. Paper No. 42) (Reply Paper No. 59)
- T3 Tanaka's Motion to Redefine II, under 37 CFR § 1.633(c)(1) and (c)(2), by substituting proposed
- count T-1 for count 1 and adding Tanaka's claims 54 and 55, and Contingent Motion to Add Count T-1. (Paper No. 23) (Opp. Paper No. 43) (Reply Paper No. 57)
- T4 Tanaka's contingent motion under 37 CFR § 1.633(c)(3) to designate claims 30-32 of Hoshino et al.'s reissue application 08/204,661 as not corresponding to count 1. (Paper No. 26) (Opp. Paper No. 36) (Reply Paper No. 56)
- T5 Tanaka's contingent motion (Paper No. 27) under 37 CFR § 1.633(a) for judgment on the ground that Hoshino et al.'s reissue application claims 18-33 are unpatentable to Hoshino et al. (Opp. Paper No. 39)
- T6 Tanaka's motion (Paper No. 28) under 37 CFR

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§ 1.633(a) for judgment that involved patent claim 17 of Hoshino et al is unpatentable to Hoshino et al. (Unopposed)

- T7 Tanaka's contingent motion under 37 CFR § 1.633(f) for benefit of Japanese applications 60-219521 and 61-058543. (Paper No. 29) (Opp. Paper No. 37) (Reply Paper No. 58)
- T8 Tanaka's motion (Paper No. 31) to excuse delay in filing certain preliminary motions. (Opp. Paper No. 38) (Reply Paper No. 55).
- T9 Tanaka's contingent motion under 37 CFR § 1.633(c)(4) to redefine by designating Tanaka's claims 6, 8-11, 13 and 14 as not corresponding to count 1 or any count. (Paper No. 30) (Opp. Paper No. 43)
- T10 Tanaka's motion or request for returning Hoshino et al.'s reply and accompanying second declaration of Ken Utagawa to Tanaka's opposition to Hoshino et al.'s Motion H2. (Paper No. 60) (Opp. Paper No. 65) (Reply Paper No. 72).
- T11 Tanaka's contingent motion (Paper No. 70) under 37 CFR § 1.633(c)(5) to require Hoshino et al. to add back to Hoshino et al.'s reissue application cancelled claims 30-32. (Opp. Paper No. 71)
- T12 Tanaka's motion to excuse delay (Paper No. 69) in filing Tanaka's contingent motion to require Hoshino et al. to add back to Hoshino et al.'s reissue application cancelled claims 30-32.

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(Unopposed)

In addition to the foregoing motions, the APJ's decision also ruled that party Hoshino's preliminary statement was not in compliance with 37 CFR § 1.622(b) and thus party Hoshino is deemed as not having filed a preliminary statement. On that ground, the APJ included an order for party Hoshino to show cause why judgment should not be issued against the junior party, for not having filed a preliminary statement.

Hoshino seeks (Paper No. 77) review of:

1. The denial-in-part of Hoshino's motions H1³ and H2.
2. The denial of Hoshino's motion H5.
3. The granting of Tanaka's motions T1, T2,⁴ and T5.

³ The APJ added Hoshino's reissue application but ruled that all claims correspond to count 1, not proposed new count 2, 3, or 4. The APJ added claims 40-53 to Tanaka's application but held that they correspond to count 1, not proposed new counts 2, 3 and 4.

⁴ The APJ designated Tanaka's amended claims 34-38 as
(continued...)

4. The sua sponte holding that Hoshino is deemed as not having filed a preliminary statement.

Tanaka does not seek review of any decision of the APJ (Paper No. 80). However, Tanaka submits that if our final decision causes any of the contingencies encompassed by its contingent motions T3, T4, T7, T9, and T11 to materialize, then the Board should consider those motions, now dismissed by the APJ, on the merits.

Opinion

The following issues will be addressed first, before our discussion of the main issues in this case, i.e., whether there should be one count or multiple counts, and which claims of the parties should correspond to the sole count or each of the multiple counts:

1. Hoshino's preliminary statement.
2. Hoshino's reissue and supplemental reissue declarations.
Tanaka's motion (T5) for judgment.
3. Hoshino's motion (H5) to excuse the delay in opposing
Tanaka's motion (T1) for benefit of the earlier
filing date of Japanese application 60-219521.

Junior Party Hoshino's

⁴(...continued)
corresponding to count 1, not proposed new count 2, 3, or 4.

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Preliminary Statement

The APJ is correct that Hoshino's preliminary statement is not in compliance with 37 CFR § 1.622(b) which requires that the preliminary statement state whether the invention was made in the United States, a NAFTA country (and which NAFTA country), a WTO member country (and which one), or in a place other than the United States, a NAFTA country, or a WTO member country. No such statement is contained in party Hoshino's preliminary statement. But where the party does not seek to introduce evidence of actual reduction to practice, as is the case with party Hoshino, the omission is harmless or inconsequential and thus the APJ abused his discretion in holding that party Hoshino is deemed as not having filed a preliminary statement.

The sufficiency of the reissue
declarations of party Hoshino's
reissue application 08/204,661

Tanaka's contingent motion for judgment (T5) asserts that claims 18-33 in Hoshino's reissue claims 18-33 are unpatentable for lack of an adequate reissue declaration. The APJ granted this motion, on the ground that the reissue declaration and supplemental reissue declaration do not

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adequately set forth how the alleged error in Hoshino's patent arose or occurred.

We cannot sustain the APJ's decision on this motion.

The APJ abused his discretion in holding that Hoshino's reissue declaration failed to particularly specify how the alleged error in the original patent arose or occurred. The error, as clearly specified in the reissue declaration, is the

failure to include the narrower claims. How the error arose or occurred, as specified in the reissue declaration and supplemental reissue declaration (filed with Hoshino's opposition to Tanaka's motion for judgment), is by failure of the inventors and representatives of the assignee to appreciate that the broader original claims may be lost in an interference contest. The APJ erred in requiring more specific facts, given that no evidence in the record has been alluded to which suggests that deceptive intention is involved with respect to Hoshino. It is true, as the APJ correctly recognized, that a concern for the potential of losing a broad claim in an interference

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priority contest can be just as legitimate as a concern for the potential of losing the broad claim on the basis of prior art.

The APJ also erred in discrediting the reissue declaration on the basis that it was not executed and signed by the inventors themselves but by an officer of the assignee. As Hoshino correctly points out, 37 CFR § 1.172(a) specifically provides that "a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the [reissue declaration] does not seek to enlarge the scope of the claims of the original patent."

Hoshino's motion to excuse the delay in opposing Tanaka's motion for benefit of the filing date of Japanese application 60-219521

On March 2, 1994, Tanaka filed a motion (T1) (Paper No. 9) for benefit of Japanese applications 60-219521 (October 2, 1985) and 61-058453 (March 17, 1986). No opposition to this Tanaka motion for benefit was filed by party Hoshino during the period for filing such opposition. On September 21, 1994, more than six months after the filing of Tanaka's motion for benefit, Hoshino filed a motion (Paper No. 34) to excuse delay in opposing Tanaka's motion for benefit, accompanied by the

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belated opposition (Paper No. 35).

According to Hoshino, it was an assertion in Tanaka's opposition to Hoshino's motion to redefine the count, which provided an excuse for Hoshino to file a belated opposition to Tanaka's motion for benefit. Hoshino argues that in Tanaka's opposition to Hoshino's motion to redefine the count, it was stated that one with ordinary skill would find it "inherent" in the count that the conversion coefficient would be corrected by utilizing both the magnitude and the sign of the defocus. Thus, according to Hoshino, if the count were to be regarded as requiring that the conversion coefficient be corrected by using both the magnitude and sign of the defocus amount, then Tanaka would not be entitled to benefit of the Japanese applications.

Like the APJ, we have difficulty comprehending the logic of Hoshino's position. At best, if the APJ in fact ruled, contrary to Hoshino's view, that the count required the correction of the

conversion coefficient be based on both the magnitude and sign

of the defocus amount, Hoshino may reasonably argue that Hoshino should get a new chance to oppose Tanaka's motion for benefit, while applying the APJ's view of the count. However, the APJ made no such determination. Indeed, on page 17 of the APJ's decision on preliminary motions, the APJ expressly stated that he has **not** construed the count that way, i.e., requiring that the conversion coefficient be corrected by using both the magnitude and sign of the defocus amount.

In the absence of a contrary determination from the APJ as to what the count actually requires, Hoshino must oppose or not oppose Tanaka's motion for benefit, based on Hoshino's own interpretation of the count. What Tanaka allegedly thinks of the count in the context of another paper, i.e., Tanaka's opposition to Hoshino's motion to redefine the count, has no bearing on and cannot properly influence whether Hoshino should, in the first instance, oppose Tanaka's motion for benefit.

Furthermore, in opposing Hoshino's motion to excuse delay, Tanaka made clear on page 5 of the opposition that it too does not interpret the count as requiring an apparatus

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that deals with "bi-directional defocus" (considering both the magnitude and sign of the defocus amount). Specifically, Tanaka stated on page 5 of the opposition: "To the contrary, Count 1 is broad enough

to encompass apparatuses dealing with uni-directional or bi-directional defocus." Tanaka further explained that the word "inherent" as used in Tanaka's opposition to Hoshino's motion to redefine the count was used to indicate what one with ordinary skill would surely have known to consider in the case of a camera having a lens that moves in both directions, and not to suggest that the count necessarily requires bi-directional defocus.

In any event, even assuming that Tanaka has taken the view that the count requires both the magnitude and sign of the defocus amount to be considered in correcting the conversion coefficient, which Tanaka denies, Hoshino can merely argue against that interpretation of the count. Until the APJ or the Board agrees with the view allegedly taken by Tanaka, the circumstance does not give Hoshino a new

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opportunity to oppose Tanaka's previously filed and unopposed motion for benefit.

We wholly agree with the following assessment of the APJ:

Such interpretation [that the conversion coefficient be corrected by using both the magnitude and sign of the defocus amount] which no one admits or agrees to, can be no basis for Hoshino et al. to justify a belated opposition to Tanaka's motion for benefit.

Because Hoshino's belated opposition to Tanaka's motion (T1) for benefit is not excused, we do not consider Hoshino's arguments why Tanaka should not be accorded the benefit of Japanese application 60-219521. It suffices to say only that the

APJ considered the substance of Tanaka's motion for benefit and deemed the arguments of Tanaka to be persuasive. We have no occasion to review Tanaka's motion (T1) for benefit de novo. Accordingly, Tanaka is entitled to benefit of Japanese application 61-058453 and 60-219521's respective filing dates of March 17, 1986 and October 2, 1985.

Hoshino's motion H2 to add proposed new counts 2, 3, and 4 and to designate various claims as corresponding or not corresponding to counts 1, 2, 3, and 4

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The APJ denied Hoshino's motion (Paper No. 14) to add proposed new counts 2, 3, and 4. That decision is presumed to have been correct and the burden of showing an abuse of discretion is upon the party attacking the order. 37 CFR § 1.655(a). An abuse of discretion occurs if the decision "(1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." Abrutyn v. Giovanniello, 15 F.3d 1048, 1050-51, 29 USPQ2d 1615, 1617 (Fed. Cir. 1994).

Before the APJ, a moving party bears the burden of proof that it is entitled to the relief sought. Kubota v. Shibuya, 999 F.2d 517, 520, 27 USPQ2d 1418, 1421 (Fed. Cir. 1993);

Patent

Interference Practice Burden of Proof - Final Rule, 58 Fed. Reg. 49432, 1155 O.G. 65, 67 (October 19, 1993). Case v. CPC Int'l, Inc., 730 F.2d 745, 750, 221 USPQ 196, 200 (Fed. Cir.), cert. denied, 105 S.Ct. 223, 224 USPQ 736 (1984).

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The APJ correctly stated that the burden is on Hoshino to demonstrate separate patentability of the proposed counts, and not on Tanaka to demonstrate lack of separate patentability.

The

APJ denied Hoshino's Motion H2 on the basis that Hoshino failed to demonstrate separate patentability of the proposed new counts. The APJ expressly stated (Decision at 9) that his decision on Hoshino's Motion H2 was reached without reliance on the evidence submitted by Tanaka in support of Tanaka's opposition to Motion H2, i.e., the Larky and Fisher declarations. The APJ also held that evidence accompanying Hoshino's reply could not bolster inadequate showings in Hoshino's prima facie case for relief.

The APJ did not specifically discuss the evidence submitted by Hoshino in a reply to Tanaka's opposition to Motion H2.

On page 7 of the attachment to the notice declaring the interference, the parties were specifically reminded that:

With respect to all motions brought under the new interference rules, the moving party bears the burden of making out a prima facie case of entitlement to the relief sought. Kubota v. Shibuya, ___ F.2d ___, 17 USPQ2d 1418, 1422-23 (Fed. Cir. 1993); Patent Interference Practice Burden of Proof - Notice of Proposed Rulemaking, 58 Fed. Reg. 528 (Jan. 6, 1993), 1147 O.G. 11 (Feb. 2,

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1993).

On the same page of the same attachment, the parties were also specifically warned that:

The parties are required to present all available relevant evidence on which they intend to rely with the motion, opposition or reply unless the evidence is already part of the interference file or the file of an involved application or patent [footnote omitted] or unless they can demonstrate that a decision on the motion should be deferred until final hearing [footnote omitted]. Furthermore, evidence submitted in support of a motion must be filed with the motion, not the reply. See Irikura v. Peterson, 18 USPQ2d 1362, 1368 (BPAI 1990):

A good faith effort must be made to submit evidence to support a preliminary motion or opposition when the evidence is available. Orikasa v. Oonishi, [10 USPQ2d 1996, 2000 n.12 (Comm'r Pats. 1989)]. Note the commentary [Final Rule Notice] 49 F.R. 48424, at 48442, . . . 1050 O.G. 393 at 411.

It is evident that the APJ determined that Hoshino's Motion H2 failed to make out a prima facie basis for relief.

Because we are of the view that Hoshino's Motion H2 failed to set forth a prima facie basis for relief, the APJ did not abuse his discretion in denying Hoshino's Motion H2 to add proposed new counts 2, 3, and 4.

Background facts

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The invention of the count is directed to a camera or photographing lens capable of performing automatic focusing.
(Count 1. Hoshino Patent. Tanaka application.)

The prior art includes autofocus cameras in which the defocus amount, i.e., the deviation of the plane on which the image is actually formed from a predetermined focal plane, is determined and then the focusing lens is moved by a lens driving means such as a motor according to the determined defocus amount. (Hoshino patent, column 1, lines 16-27.)

In such preexisting cameras, the relationship between the lens driving amount and the defocus amount is defined by a conversion coefficient K which is a constant. (Hoshino patent, column 1, lines 28-36).

Both Hoshino and Tanaka propose using a corrected coefficient which is not a constant, rather than a conversion coefficient which is a constant. (Hoshino patent, column 1, line 68 to column 2, line 9, and column 3, lines 8-18; Tanaka application, pages 12-13).

According to Hoshino, this corrected coefficient is defined by the formula $K_0(1 + C_0 \times \hat{B}f)$ where K_0 is the original conversion coefficient, C_0 is a correction

coefficient, and $\hat{I}Bf$ is the defocus amount. (Hoshino patent, column 4, lines 12-39).

According to Tanaka, this corrected coefficient is called S_d and is determined by the formula: $S_d = S_0 + A \times f(\hat{I}d)$ where S_0 represents the original constant conversion coefficient (like K_0 in Hoshino's patent), A is a correction coefficient like Hoshino's C_0 , and $f(\hat{I}d)$ represents a function of the focus deviation $\hat{I}d$ (like the defocus amount $\hat{I}Bf$ in Hoshino's patent). (Tanaka application, pages 12-13).

Discussion

At issue before us is whether Hoshino's Motion H2, together with the evidence submitted therewith, is sufficient to make out a prima facie basis for the relief sought. We conclude, for reasons discussed in more detail below, that it does not. Like the APJ did in rendering the decision on motions, we have not considered the new points contained in and the evidence submitted with Tanaka's opposition to Hoshino's Motion H2. Accordingly, Hoshino's reply and evidence submitted with the reply need not be and have not been considered. Per 37 CFR § 1.638(b)(1993),

"[a] reply shall be directed only to new points raised in the opposition." To the extent that Hoshino believes that Motion H2 itself makes out a prima facie basis for relief, we disagree.

In order to add a count to the interference, party Hoshino must demonstrate that the newly proposed count defines a separately patentable invention relative to original count

1. According to count 1, the "corrected conversion coefficient" representing a relationship between the lens driving amount and the detected amount of defocus is determined **on the basis** of three factors:

(1) the conversion coefficient, (2) the correction coefficient, and (3) **the detected amount of defocus.**

Hoshino's proposed count 2 differs from count 1 by specifically and particularly reciting that the corrected conversion coefficient is determined in accordance with a formula that depends on both the magnitude and sign of the detected amount of defocus.

Hoshino's proposed count 3 differs from count 1 by specifically and particularly reciting that the formula for

determining the corrected conversion coefficient has a first order term of the detected amount of defocus and also depends on both the magnitude and sign of the amount of defocus.

Hoshino's proposed count 4 differs from count 1 by specifically reciting that the formula for determining the corrected conversion coefficient has both a first order term and a higher order term of the detected amount of defocus, with the first order term including a first correction coefficient and the higher order term including a second correction coefficient.

Per 37 CFR § 1.601(n), the standard for determining separately patentable invention is the same as obviousness under 35 U.S.C. § 103.

Hoshino's Motion H2 is accompanied by a single supporting declaration of a co-inventor of Hoshino's involved patent, Ken Utagawa (first Utagawa declaration). The declaration has five items attached thereto, i.e., Exhibits A, B, C, and D, and a curriculum vitae of Mr. Utagawa. That Mr. Utagawa is an expert in the design of autofocus cameras has not been disputed by

senior party Tanaka. In this first declaration, Mr. Utagawa makes three points which are especially pertinent to the issue of adding proposed new counts 2, 3, and 4:

(1) (pages 2-3) [W]hen focusing is based on a corrected conversion coefficient K determined in accordance with a formula having a first order term of the detected amount of defocus, there is **a substantial improvement** in the accuracy of focusing, as compared to focusing based on a corrected conversion coefficient determined in accordance with a formula that lacks a first order term of the detected amount of defocus. For example, a formula that has merely a second order term of the detected amount of defocus produces a substantial error in the corrected conversion coefficient, as is apparent from a comparison of line M1 and the second order curve superimposed on Fig. 3 in Exhibit A.

(2) (pages 3-4) [W]hen the calculating means determines the corrected conversion coefficient in accordance with a formula having a first order term of the detected amount of defocus and that depends on both the magnitude and the sign of the detected amount of defocus, there is **a substantial improvement** in focusing accuracy, as compared with focusing based on a corrected conversion coefficient determined in accordance with a formula that produces the same corrected conversion coefficient regardless of the sign of the detected amount of defocus. This is apparent in Fig. 3 of Exhibit B attached hereto in which the first order dash line M1' (producing the same value of K regardless of the sign of $\hat{B}f$) shows a substantial error (divergence from line M1) in determination of the corrected conversion coefficient K for $-\hat{B}f$. Similarly, in Exhibit A, there is a substantial error when the

corrected conversion coefficient K is determined in accordance with a second order curve that produces the same value of K for $-\hat{I}Bf$ as for $+\hat{I}Bf$.

(3) (pages 4-5) By employing two (or more) correction coefficients in determining the corrected conversion coefficient, **improved focusing accuracy** is obtained, since the corrected conversion coefficient (K) can be calculated more precisely.

(Page 5) More accurate focusing can be achieved with such a formula [a first order and a higher order term of the detected amount of defocus, having respective first and second correction coefficients], because the corrected conversion coefficient can be calculated more precisely when accounting for the fact that the relationship between the corrected conversion coefficient and the detected amount of defocus is not entirely a straight-line relationship in some lens systems.

We have many problems with Hoshino's arguments and evidence, as was presented in motion H2, in support of the contention that each of the proposed new counts 2, 3, and 4, represents a separately patentable invention, i.e., an invention that is patentably distinct, from count 1.

An expert's affidavit, if it presents mere conclusions and few facts to buttress the opinions proffered, fails in its purpose, and is entitled to little weight. See, e.g., In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). Note also the following statement of the Court of Appeals for the Federal Circuit in Rohm and Haas Co. v.

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Brotech Corp., 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997): "Nothing in the rules or in our jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness." Mr. Utagawa's above-quoted statement merely asserts, in a conclusory manner, that a "substantial improvement" is achieved, without describing the actual systems used, if any, or revealing

the raw test data, if any. No specific test with particular components has been identified. It is not known whether the alleged improvement is achieved with one, two, several, or many types of actual optical systems.

Moreover, the attachment to the notice declaring the interference warned the parties not only that evidence in support of a preliminary motion must be submitted together with the motion and not with the reply, but also that (page 8):

A party offering affidavit testimony by an alleged expert must establish that the affiant is an expert in the sense of Rule 702 of the Federal Rules of Evidence. **Expert opinion testimony pursuant to Fed. R. Evid. 703 is entitled to weight only to the extent the underlying factual basis is provided in**

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the affidavit. Cable Electric Prod. v. Genmark, 770
F.2d 1015, 226 USPQ 881, 887 (Fed. Cir. 1985).
(Emphasis added.)

Further still, it is anyone's guess how much improvement constitutes a "substantial improvement." Since we do not know how much improvement constitutes "substantial improvement," the assertion of substantial improvement is not very meaningful. The Figures referred to in Exhibits A and B attached to Mr. Utagawa's first declaration are not marked with specific units on any axis in the graphs and do not appear to record actual test data. Rather, they appear to be graphical illustrations or translations of what Mr. Utagawa has said in words and are just as conclusory. Saying the same thing twice, albeit in different forms, does not

make an unsubstantiated conclusion any more believable or convincing. Also, here, the fact that Mr. Utagawa is a co-inventor makes lack of presentation of the underlying factual basis and specific data in support of Mr. Utagawa's opinion even a little more suspect.

Even assuming that substantial improvements are shown,

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whatever that is, and further assuming that the improvement is with respect to all types of optical systems, it should be noted that it is only "unexpected" beneficial results which are an objective indicia of nonobviousness, see, e.g., In re Baxter Travenol Labs, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), and **not** any "expected" beneficial results. To the contrary, expected beneficial results are strong evidence of obviousness of the claimed invention, just as unexpected beneficial results are evidence of unobviousness. In re Skoll, 523 F.2d 1392, 1397, 187 USPQ 481, 484 (CCPA 1975); In re Skoner, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975); In re Gershon, 372 F.2d 535, 537, 152 USPQ 602, 604 (CCPA 1967).

Mr. Utagawa's declaration accompanying Motion H2 nowhere asserts, much less establishes or demonstrates that the so-called "substantial improvements" or mere improvements are unexpected. We decline to simply assume that the alleged improvements are or

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would have been **unexpected** to one with ordinary skill in the art. That important fact has to be alleged and established by Hoshino as the moving party, if Hoshino relies on beneficial results as an indicia of nonobviousness.

To the extent that Hoshino's Motion H2 does, only with respect to proposed new count 2, allege that the improvement would not have been obvious to one with ordinary skill in the art, note that (1) argument of counsel does not take the place of evidence, Estee Lauder, Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997); Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854 (1977); In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974), (2) nonobviousness does not equate to unexpectedness since something nonobvious is not necessarily surprising, and (3) when unexpected results are asserted, it must be shown by comparison of the claimed invention's results with the result obtained by the closest prior art. In re Baxter Travenol Labs, 952 F.2d at 392, 21 USPQ2d at 1285; In re De Blauwe, 736 F.2d at 705, 222 USPQ at 196. Here, no specific information accompanied the first Utagawa declaration to show what particular tests were made

and what the actual results were.

Consequently, all of Hoshino's conclusory assertions of improvement, in the motion, do not help to establish nonobviousness in a meaningful way. Our opinion should not be read as saying that unexpected results are necessary to show nonobviousness. Rather, we simply note that Hoshino's motion H2 did not, with respect to the proposed new counts, assert and present evidence of "unexpected results," an objective indicia of nonobviousness, which if shown, can help to demonstrate nonobviousness.

Additionally, it would appear that given the general recitation of count 1, i.e., that the corrected conversion coefficient is determined on the basis of the detected amount of defocus, one with ordinary skill in the art would have appreciated that some results would be better than others depending on the precise calculation formula used. And because count 1 specifically mentions the amount of defocus as a factor and not the amount of defocus squared, cubed, or raised to any other higher order, it is more plausible that given count 1 one would naturally expect better results with formulas having a first order term of the detected amount of

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defocus, if it is even assumed that there is any expectation at all.

Also, because count 1 specifically mentions the amount of defocus as a factor and not the amount of defocus squared, cubed, or raised to any other higher order, there is at least some motivation for one with ordinary skill in the art to include a first order term of the defocus amount in the formula. Note that

a first order term is almost precisely what the count literally says. It takes additional cognitive figuring or at least another mental step to realize that the count is not limited only to formulas having a first order term of the defocus amount.

With respect to separate patentability between proposed new counts 2 and 3, we note that the statements of Mr. Utagawa in the declaration accompanying Motion H2 do not demonstrate anything meaningful with respect to the sign dependence feature separate and apart from the idea of having a first order term of the

defocus amount in the calculation formula. Specifically, if the presence of a first order term of the defocus amount is what causes a substantial improvement according to one part of Mr. Utagawa's declaration, then the improvement due to a combination of having a first order term and dependence on the sign of the defocus amount cannot be attributed solely to dependence on the sign of the defocus amount. It should be noted that a first order term of the defocus amount necessarily attributes significance to the sign of the defocus amount. Unlike the case with terms raised to an even number power, the sign is not lost with a first order term. For these reasons, Motion H2 has not sufficiently distinguished proposed new count 2 from proposed new count 3.

With respect to proposed new count 4, Mr. Utagawa essentially states that using an additional higher order term together with a first order term of the detected amount of defocus yields further improvement because in some lens systems the relationship between the corrected conversion coefficient and the detected amount of defocus is not entirely a straight-line (linear) relationship. It is implicit that at least in some lens systems the relationship is strictly linear

and no meaningful improvement would be achieved by the addition of a higher order term of the defocus amount to the formula for calculating the corrected conversion coefficient. But none of count 1 or proposed new counts 2, 3, and 4, is limited to any particular type of lens system. Thus, the assertion of improvement is not commensurate in scope with proposed new count 4.

Given count 1 which recites that the corrected conversion coefficient is calculated on the basis of the detected defocus amount and which does not exclude higher order terms, that higher order terms may be present to accompany a first order term of the defocus amount follows from a straight reading of count 1 and thus would be readily appreciated by one with ordinary skill in the art who is presumed to possess basic reading skills and certain level common sense. See, e.g., In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

The parties should not overlook or lose sight of the fact that insofar as Hoshino's Motion H2 is concerned, Hoshino must

successfully demonstrate separate patentability (nonobviousness) of the proposed new counts with respect to count 1 and each other. For an affirmance of the APJ's denial of Hoshino's Motion H2, it is not necessary for us to conclude that the proposed new counts would have been obvious with respect to count 1.

In portions of its brief, Hoshino presents another line of argument in support of the assertion that the proposed new counts are separately patentable from count 1. In essence, according to Hoshino (Hoshino brief at 14 and 31), even Tanaka, an expert in the art of designing autofocus cameras, in 1985 when he filed Japanese priority application 60-219521 (JP '521), did not think of a formula having a first order term of the detected amount of defocus or utilizing the sign of the defocus amount but instead, settled on a second order function based on $\hat{I}d^2$, i.e., $S_a = S_0 + A \times \hat{I}d^2$.

Hoshino points out (Br. at 32-33) that it was Tanaka's second Japanese priority application which specifically judges the sign (direction) of the defocus, so that the sign may be utilized in calculating the corrected conversion coefficient. According to Hoshino (Br. at 32), it was "months" after the

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date of Tanaka's first Japanese priority application, when Tanaka filed the second Japanese priority application (61-058453), that Tanaka recognized the need for considering the sign of the

defocus amount in calculating the corrected conversion coefficient.⁵

Hoshino also states (Br. at 39) that until the filing of Tanaka's involved United States application, Tanaka, "an expert in designing autofocus cameras," did not even mention [in the two Japanese priority applications] a formula including a first order term of the defocus amount for calculating the corrected conversion coefficient.

Hoshino's line of argument based on what Tanaka did or did not describe in the first and/or second Japanese priority application was not presented in Hoshino's original Motion H2 (Paper No. 14). Thus, the APJ could not have erred or abused

⁵ Tanaka's first Japanese priority application 60-219521 has a filing date of October 2, 1985. Tanaka's second Japanese priority application 61-058453 has a filing date of March 17, 1986.

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his discretion, on account of this new line of argument, in determining that Hoshino failed to set forth a prima facie basis for relief. In any event, however, Hoshino's argument is both speculative and presumptuous, and is rejected.

That Tanaka did not specifically describe using the sign of the defocus amount until the second Japanese priority application and a first order term of the defocus amount until the instant directly involved U.S. application does not demonstrate something

significant regarding the obviousness or unobviousness of using the sign of the defocus amount or a first order term thereof. In our view, it is without basis for Hoshino to conclude that the reason Tanaka did not describe a particular embodiment is that the embodiment was not obvious to Tanaka. Tanaka's first Japanese priority application may not contain a written description of Hoshino's proposed new counts 2, 3, and 4, but it is a long and fanciful stretch from there to conclude that the lack of description demonstrates nonobviousness to Tanaka.

Moreover, Hoshino does not dispute that Tanaka did disclose, in the second Japanese priority application (61-058453) a formula utilizing the sign of the defocus amount, and in the involved U.S. application a formula utilizing a first order term of the defocus amount. The most that can be said is that Tanaka specifically described a formula using a second order term of the defocus amount before he described a formula using a first order term. There may be a countless number of reasons that may account for that order of events, only one of which is the possibility that it was not obvious to Tanaka that the formula can include a first order term of the defocus amount. There is and can be no rule that all embodiments of an invention which is not described in the very first patent application filed by the inventor in a series of patent applications around the world are

presumed to have been unobvious to the inventor. Furthermore, actual disclosure of the feature or features at issue in any of Tanaka's patent applications, e.g., the second Japanese priority application or the involved U.S. application,

undermines Hoshino's contention that the features were unobvious to Tanaka. We note further that even Hoshino recognizes (Br. at 39) that in Tanaka's first Japanese priority application there is a statement that higher order equations may be employed. Indeed, on page 20 of the English translation of Tanaka's first Japanese priority application 60-219521 contained in the file of Tanaka's involved application, it is stated that a function other than the second order function, "for example, a **tertiary** or higher-order function" (emphasis added) can be adopted. Tertiary means third order. The language suggests that Tanaka was aware that third order equations may be used. A third order equation, unlike a second order equation, does not ignore the sign of the detected defocus amount. A number raised to the third power preserves its original sign. These facts further erode Hoshino's argument about what was not obvious to Tanaka.

For all of the foregoing reasons, it is clear that Hoshino's Motion H2 has failed to set forth a prima facie case that the proposed new counts 2, 3, and 4 define separately patentable, i.e., patentably distinct, inventions with respect to count 1.

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Even if there had been no opposition from Tanaka, Hoshino's Motion H2 should have been denied by the APJ, as it was. The APJ made clear that he did not consider the Larky and Fisher declarations accompanying Tanaka's opposition to Hoshino's Motion H2. The lack of a prima facie showing in Hoshino's Motion H2 is determined independent of any evidentiary showing by Tanaka. The lack of specific factual basis for the conclusions expressed in Mr. Utagawa's first declaration, the vagueness of what constitutes "substantial" improvement, and the lack of showing for "unexpectedness," all serve to support the APJ's determination regardless of anything said in the Larky and Fisher declarations. We also agree with the following finding of the APJ (Motions Decision at 8):

The APJ also finds that all of the alleged substantial improvements in Ken Utagawa's first declaration are not supported by quantitative experimental results. What is "substantial" to one may not be substantial to another. And Hoshino et al. have failed to establish the extent of any such allegedly "substantial" improvement through objective and specific experimental data.

Hoshino's reply to Tanaka's opposition is accompanied by an additional declaration of Mr. Utagawa (second Utagawa

declaration), and also the declarations of Mr. Yoshiharu Shiokama and co-inventor Yoshinari Hamanishi. In addition to attacking the expert status of Tanaka's witnesses Larky and Fisher and the opinions of Larky and Fisher, the second Utagawa declaration attempts to present, for the first time, specific details of the underlying activities possibly supporting the conclusory opinions in Utagawa's first declaration. The events and various projects leading up to Mr. Utagawa's forming his expert opinions and conclusions were described, including the extent and variety of the optical systems tested. Tables and graphs of specific data were introduced in exhibits to the second Utagawa declaration. The Shiokama declaration describes the nature and significance of a certain table and graphs submitted together therewith for various Nikon® and Canon® lenses. The Hamanishi declaration states an opinion to support the opinions in the second Utagawa declaration. Also, the second Utagawa declaration mentioned, for the first time, that a strong first order relationship was "unexpected."

We cannot state more strongly that the time for Hoshino

to indicate any unexpectedness in the alleged beneficial results is in its motion, not in a reply to Tanaka's opposition. We also cannot state with more emphasis that the time for Hoshino to submit specific experimental or test data to provide a factual basis for the mere assertion, in the motion, of substantial beneficial results is in the motion, not in a reply to Tanaka's opposition.

The deficiencies in Hoshino's prima facie case cannot be remedied or repaired by way of a reply. The issues are central to Hoshino's claim for relief. The assertion of any unexpected substantial beneficial results and the factual basis for Mr. Utagawa's opinions are undeniably a part of Hoshino's "case-in-chief" for Motion H2 and thus must be raised or presented together with Hoshino's Motion H2, if at all, not in a reply. Hoshino assumes the risk that without such crucial evidence and assertion of "unexpectedness," Mr. Utagawa's first declaration which was submitted with Motion H2 and the arguments contained in Motion H2 are inadequate to support the relief requested in Motion H2, as we have determined here. Note also 37 CFR § 1.639(a) (1993), which states:

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Proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition [sic], or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

The exceptions clearly have no application here.

According to Hoshino (Br. at 25), the evidence submitted with the reply and the arguments in the reply are properly directed toward Tanaka's opposition to Hoshino's Motion H2 and only "coincidentally" bolster Hoshino's original showings for establishing a prima facie case for relief. Also according to Hoshino (Br. at 25), "coincidental" bolstering is not improper.

We disagree. The bolstering cannot be proper and merely "coincidental" where, as here, the original motion with the first Utigawa declaration does not establish a prima facie case for relief. Because Hoshino's motion fails even without our consideration and reliance on Tanaka's opposition to the motion, additional evidence cannot, under the guise of a reply, remedy the lack of a prima facie showing in the

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original motion. The filing of an opposition does not provide the movant a back door to submit evidence which should have been submitted with the original motion. The omission is even more inexcusable here, where 37 CFR § 1.639(a) and prior explicit warning from the APJ placed the parties on notice that evidence needed to support a motion must be filed with the motion and not with the reply. As we indicated earlier, the APJ further stated in advance to the parties that with respect to all preliminary "motions" the moving party bears the burden of establishing a prima facie case of entitlement to relief. Also, 37 CFR § 1.638(b) states that a reply shall be directed only to new points raised in the opposition.

The Board has a substantial backlog in interference cases. If a moving party's original motion papers and evidence in support of the motion do not demonstrate a prima facie basis for relief, regardless of any opposition to the motion, as we have

determined here, the motion should be denied and the movant

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does not get an opportunity to complete a prima facie showing by reliance on evidence submitted in the name of a "reply." If such non-reply replies are considered and given weight, it can give rise to at least a full round of surreply with additional evidence for consideration and possibly even a further reply to address new issues raised in the surreply. A breakdown of the orderly procedure to present issues and evidence for consideration occurs, causing confusion and delay in the interference proceeding.

This is not a matter of not allowing Hoshino to reply to the opposition of Tanaka. But rather, Hoshino's motion fails even without our reliance on Tanaka's opposition to Hoshino's motion.

Consequently, there is no occasion to consider Hoshino's reply and evidence submitted therewith.

For the foregoing reason, we sustain the APJ's denial of Hoshino's motion to add proposed new counts 2, 3, and 4, and also sustain the APJ's decision to designate all of Hoshino's involved claims and Tanaka's involved claims as corresponding to count 1, not any one of Hoshino's proposed new counts 2, 3, and 4. The details of which claims according to Hoshino

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correspond to a proposed new count can be ascertained by
reference to pages 1 and 2 of Hoshino's Motion H2 (Paper No.
14) and page 49 of

Hoshino's brief. A copy of Hoshino's Motion H2 and the APJ's
decision on preliminary motions is enclosed.

Tanaka's Motion to Suppress

Tanaka filed a paper (Paper No. 96) captioned "Motion to
Suppress" requesting the Board to rule that the second Utagawa
declaration filed with Hoshino's reply to Tanaka's opposition
to Hoshino's Motion H2, together with its Exhibits G, H, and
I, "are inadmissible on the ground that they are untimely for
introducing new evidence and argument at the reply stage."
Alternatively, Tanaka requests that paragraphs 5-14, 16, 17,
and 19 of the second Utagawa declaration and Hoshino's
exhibits G, H, and I should be suppressed and not considered
by the Board.

Because we have sustained the APJ's decision on Hoshino's
Motion H2 based on Hoshino's lack of showing of a prima facie
basis for relief in the motion itself, without regard to new

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points raised in and evidence presented with Tanaka's opposition, there has been no occasion to consider the substance of paragraphs 5-14, 16, 17, and 19 of the second Utagawa declaration and Hoshino's exhibits G, H, and I. Accordingly, Tanaka's motion to suppress is dismissed as moot.

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Judgment

Because the effective filing date of Hoshino et al.'s involved patent and reissue application is January 22, 1986, and the effective filing date of Tanaka's involved application is October 2, 1985, judgment is herein entered against junior party Hoshino et al. Accordingly, Kunihiisa Hoshino, deceased, by Chie Hoshino, legal representative, Yoshinari Hamanishi, and Ken Utagawa, are not entitled to claims 1-33 of their reissue application 08/204,661, which correspond to count 1, and are not entitled to claims 1-17 of their involved patent 4,841,325, which correspond to count 1. Judgment is herein awarded to senior party Tanaka. Tsunefumi Tanaka, on this record, is entitled to claims 1, 2, 5, 6, 8-11, 13-33, amended claims 34-38, and added claims 40-53 which correspond to count 1.

	_____))	
	BRUCE H. STONER, JR.)	
	Chief Administrative Patent Judge))	
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PATENT	_____))	APPEALS

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WILLIAM F. PATE, III
Administrative Patent Judge

AND INTERFERENCES

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